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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,332	10/23/2001	Masaki Ohira	16869P-027000US	9285

20350 7590 07/25/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
LI, SHI K	

ART UNIT	PAPER NUMBER
2633	

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,332	OHIRA ET AL.	
	Examiner	Art Unit	
	Shi K. Li	2633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6 and 8-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6 and 8-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 15 recites the limitation "if said first and second monitoring zones do not overlap, then said first and second portions of said transmission signal are the same portion". However, the instant specification teaches in page 7, lines 5-7 that the portion of overhead for zone i is region Xi. If two zones are not the same, their regions are not the same. This contradicts the claimed invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "identifying a second optical transmission device" in line 10 of the claim and the limitation "a second optical transmission device" in lines 19-20 of the claim. It is unclear whether they refer to the same optical transmission device or different optical

transmission device. If they refer to different optical transmission devices, it is suggested that different ordinal numbers be used for them.

6. Claim 5 recites the limitation "The method of claim 4" in line 1 of the claim. However, claim 4 has been canceled.

7. Claim 6 recites the limitation "The method of claim 4" in line 1 of the claim. However, claim 4 has been canceled.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-3, 5-6, 8-18 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fee et al. (U.S. Patent 5,956,165) in view of Joline et al. (U.S. Patent 6,005,696).

Regarding claim 1, Fee et al. discloses in FIG. 4A, FIG. 4C and col. 12, lines 60-col. 13, line 2 a method for monitoring optical link. FIG. 4A comprises a network management system 460 for communicating with various optical transmission devices including endpoint 301. Fee et al. teaches in FIG. 9A that such method can be applied to provide network management for a network with a plurality of nodes. Fee et al. teaches in col. 13, line 52-col. 14, line 9 that the method can be applied to a path with node 901 as the beginning of the path, node 905 as the end of the path and nodes in between, such as node 902, as relay nodes. Overhead signal (subcarrier signal) is inserted at node 901, pass through node 902 and detected at node 905. The difference between Fee et al. and the claimed invention is that Fee et al. does not teach to monitor a plurality of paths. However, it is obvious that the same method can be applied to various paths of a network. For example, Joline et al. teaches in FIG. 2 a network with a plurality of nodes

within the state of Pennsylvania and teaches in col. 9, lines 38-58 to test the circuit between Scranton and Harrisburg and the circuit between King of Prussia and Harrisburg. It is an obvious extension to test three paths, for example between Pittsburgh and Altoona, between Scranton and Harrisburg and between King of Prussia and Harrisburg. One of ordinary skill in the art would have been motivated to combine the teaching of Joline et al. with the optical monitoring method of Fee et al. to monitor all paths of a network because such approach ensures performance for each and every path in a network.

Regarding claim 2, Joline et al. teaches in FIG. 5 a method for testing a network. The first step of the method is to get user input for test parameters as illustrated as step 501 in FIG. 5. Joline et al. teaches in col. 11, lines 60-63 that user input includes information about type of test and circuit at which the test is applied. One of ordinary skill in the art would have been motivated to combine the teaching of Joline et al. with the modified optical link monitoring method of Fee et al. and Joline et al. because receiving user input allows craftsperson to pick and choose the type of test and the part of the network at which the test is applied and, therefore, quickly obtain information that is needed. This provides great flexibility to the method. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a step of receiving user input, as taught by Joline et al., in the modified optical link monitoring method of Fee et al. and Joline et al. because receiving user input allows craftsperson to pick and choose the type of test and the part of the network at which the test is applied and, therefore, quickly obtain information that is needed.

Regarding claims 3 and 9, as taught by Joline et al., the first instruction signal includes, as a portion, the type of test.

Regarding claims 5 and 6, Joline et al. teaches in col. 10, line 12-15 maintenance and operations console (MOC) and in FIG. 5, step 508 that test results are sent to the test system user at the MOC. The MOC is equivalent to the network management system of Fee et al.

Regarding claim 8, Fee et al. teaches using subcarrier (overhead) signal for monitoring. Fee et al. teaches in col. 14, lines 21-25 that when a relay node receives a transmission signal, the original subcarrier signal, generated at the beginning node, is not subtracted off.

Regarding claim 10, Joline et al. teaches in FIG. 5, step 503 that the MOC sends instructions to add/drop multiplexers.

Regarding claim 11, Joline et al. teaches in FIG. 5, step 508 that test results are sent to the test system user at the MOC.

Regarding claim 12, Joline et al. teaches in col. 9, lines 38-58 that the test center dynamically configures monitoring zones. For example, a first monitoring zone is between Scranton and Harrisburg, and a second monitoring zone is between King of Prussia and Harrisburg, as illustrated in FIG. 2.

Regarding claim 13, Joline et al. teaches in FIG. 5 step 501 for getting user input.

Regarding claims 14-15, Joline et al. teaches in col. 11, lines 61-65 that user specifies the test type and monitoring zone. Two zones can overlap and have different test types. When two zones do not overlap, they can have same test types.

Regarding claim 16, Fee et al. teaches in col. 14, lines 21-25 that when a relay node receives a transmission signal, the original subcarrier signal, generated at the beginning node, is not subtracted off.

Regarding claim 17, Fee et al. teaches in col. 14, lines 1-9 that end-point device process subcarrier signal for path monitoring.

Regarding claim 18, as taught by Joline et al., the insertion-type instruction signal includes, as a portion, the type of test.

Regarding claims 19-20, Joline et al. teaches in FIG. 5, step 503 that the MOC sends instructions to add/drop multiplexers and in step 508 that test results are sent to the test system user at the MOC.

Response to Arguments

10. Applicant's arguments filed 31 March 2005 have been fully considered but they are not persuasive.

The Applicant argues that Fee et al. does show identifying specific devices in each of the optical transmission paths to be monitored. The Examiner disagrees. Fee et al. teaches in col. 13, lines 52-67 that node 901 is a beginning node, node 902 is a relay node and node 905 is an end node.

The Applicant argues that Joline et al. does not show identifying specific devices in each of first, second and third optical transmission paths to be monitored. The Examiner disagrees. Joline et al. teaches in col. 10, lines 22-24 that user identifies the circuit to be tested.

The Applicant argues that Fee et al. does not show or suggest transmitting first, second and third instructions respectively to the first, second and third optical devices. The Examiner disagrees. Fee et al. teaches in FIG. 4A network management system for sending instructions. Subcarrier signal is added at node 301. Similarly, node 902 and node 905 of FIG. 9A are also

under the control of network management system to pass on subcarrier signal or detect and process subcarrier signal.

The Applicant argues that Joline et al. does not show transmitting first, second and third instructions respectively to the first, second and third optical devices. The Examiner disagrees. Joline et al. teaches in FIG. 5, step 503 that control instructions are sent to add/drop multiplexers.

11. Applicant's arguments with respect to claims 12-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shi K. Li whose telephone number is 571 272-3031. The examiner can normally be reached on Monday-Friday (8:30 a.m. - 5:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on 571 272-3022. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

skl
15 July 2005

Shi K. Li
Patent Examiner